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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,112	09/26/2003	Denny Jaeger	4207/CIP/2	7733

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EXAMINER

HONEYCUTT, KRISTINA B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/672,112	Applicant(s) JAEGER, DENNY	
	Examiner Kristina B. Honeycutt	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed September 26, 2003 which is a continuation-in-part of an application filed February 15, 2001.

This action is made **Non-Final**.

2. Claims 1-8 are pending in the case. Claim 1 is an independent claim.

Priority

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Drawings

4. The drawings filed on September 26, 2003 are accepted.

Specification

Claim Objections

5. Claim 2 is objected to because of the following informalities:

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Claim 2 states "The method of claim 2, wherein...". It is unclear as to what is meant by the claim but for purposes of examination is understood to read "The method of claim 1, wherein...".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites the limitation "the beginning" in line 12. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1 and 2 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 30 and 31 of copending Application No. 10/635704. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3, 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Forcier (U.S. Patent 6499043; date of patent December 24, 2002; filed September 12, 1996).

Regarding independent claim 1, Forcier discloses in an electronic device that accepts drawn graphic entries and includes a screen display, a method for creating headings in text displayed on the screen, including the steps of:

- drawing a staircase object having at least one vertical segment joined to at least one horizontal segment to define at least one step (Figures 4 – 4H; col. 14, lines 5-16 – as demonstrated in the figures and cited text, a staircase object can be drawn that defines a step since Forcier teaches drawing line segments horizontally and vertically, which can form a staircase, and associating functions with the gestures);
- recognizing the drawn staircase object (col. 14, lines 16-21 – as demonstrated in the cited text, a staircase object is recognized since Forcier teaches presenting the user with a representation of the gesture);
- entering at least one alphanumeric character adjacent to said at least one step to define a heading style for said at least one step and create a staircase formatting object (Figure 7F; col. 11, lines 45-51; col. 28, lines 53-67; col. 29, lines 1-2 – as demonstrated in the figure and cited text, characters are entered that define a style and formatting since Forcier teaches entering text and defining headings in text);
- substituting a graphic object for said at least one alphanumeric character (col. 40, lines 20-26 – as demonstrated in the cited text, an object is substituted for a character since Forcier teaches replacing characters in an image);

- thereafter automatically creating a heading having said graphic object wherever said at least one alphanumeric character appears at the beginning of a line in said text (Figure 7Q; col. 16, lines 25-33; col. 28, lines 53-67; col. 29, lines 1-2 – as demonstrated in the figure and cited text, a heading is created when an object is placed in text since Forcier teaches functions, including creating a heading, being applied every time a gesture is performed).

Regarding dependent claim 2, Forcier discloses the method of claim 2, wherein the step of substituting includes placing said graphic object onscreen, and drawing an arrow from said graphic object to said at least one alphanumeric character of said staircase formatting object (Figures 7B, 7C; col. 28, lines 1-8 – as demonstrated in the figures and cited text, an arrow is drawn onscreen between objects and characters since Forcier teaches drawing an arrow from the point onscreen to the text).

Regarding dependent claim 3, Forcier discloses the method of claim 1, wherein said graphic object comprises a bullet (Figures 4-4H; col. 40, lines 20-26 – as demonstrated in the figures and cited text, the object is a bullet).

Regarding dependent claim 8, Forcier discloses the method of claim 1, further including the step of assigning the placement of said graphic object in said heading to a designated keyboard function key, whereby pressing said designated keyboard function key at the beginning of a line in said text causes said graphic object to appear in said

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heading (col. 7, lines 24-28 – as demonstrated in the cited text, functions are assigned to keyboard function keys).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forcier in view of Nagasawa et al. (U.S. Patent 6768928; date of patent July 27, 2004; filed May 18, 2000).

Regarding dependent claim 4, Forcier does not disclose the step of displaying an Info Canvas for said graphic object. Nagasawa teaches displaying a canvas for the objects (Figure 1; col. 5, lines 65-66). It would have been obvious to one of ordinary skill in the art, having the teachings of Forcier and Nagasawa before him at the time the invention was made, to modify displaying the object as taught by Forcier to include a canvas for displaying objects as taught by Nagasawa, because including a canvas for displaying objects, as taught by Nagasawa (Figure 1; col. 5, lines 65-66), would allow the user to perform functions on the object through the canvas.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forcier in view of Nagasawa in further view of Tognazzini (U.S. Patent 5850211; date of patent December 15, 1998; filed June 26, 1996).

Regarding dependent claim 5, Forcier does not disclose the step of providing a selection in said Info Canvas to enable selecting and deselecting display of said graphic object in said heading. Tognazzini teaches selecting and deselecting objects for display (col. 2, lines 53-57; col. 7, lines 16-35). It would have been obvious to one of ordinary skill in the art, having the teachings of Forcier and Tognazzini before him at the time the invention was made, to modify displaying the object as taught by Forcier to include a selecting and deselecting objects for display as taught by Tognazzini, because selecting and deselecting objects for display, as taught by Tognazzini (col. 2, lines 53-57; col. 7, lines 16-35), would allow the user to easily choose which objects were displayed by using well-known methods of selection and deselection.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forcier in view of Nagasawa in further view of Jorna et al. (U.S. Patent 6029172; date of patent February 22, 2000; filed August 19, 1997).

Regarding dependent claim 6, Forcier does not disclose providing a Category selection in said Info Canvas to enable display of said graphic object in said heading

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whenever an alphanumeric character having a categorical similarity to said at least one alphanumeric character is placed at the beginning of a line in said text. Jorna teaches displaying objects with categorical similarity (abstract) since Jorna teaches displaying names of sub-categories that are at the same level as a category. It would have been obvious to one of ordinary skill in the art, having the teachings of Forcier and Jorna before him at the time the invention was made, to modify displaying the object as taught by Forcier to include displaying objects based on categorical similarity as taught by Jorna, because categorical similarity, as taught by Jorna (abstract), would allow the user to easily display objects for related characters since the object is displayed when any character having categorical similarity is recognized.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forcier in view of Nagasawa in further view of Henry, Jr. (U.S. Patent 5881169; date of patent March 9, 1999; filed September 13, 1996).

Regarding dependent claim 7, Forcier discloses displaying graphic objects in said heading only when at least one alphanumeric character is placed at the beginning of a line in said text (Figure 7Q; col. 16, lines 25-33; col. 28, lines 53-67; col. 29, lines 1-2) but does not disclose providing a Individual Character selection in said Info Canvas. Henry teaches individual character selection (col. 3, lines 36-44). It would have been obvious to one of ordinary skill in the art, having the teachings of Forcier and Henry before him at the time the invention was made, to modify displaying the object as taught

by Forcier to include individual character selection as taught by Jorna, because individual character selection, as taught by Henry (col. 3, lines 36-44), would allow the user to easily select specific characters for recognition.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Process control (U.S. Patent 6834388);
- Application testing with virtual object recognition (U.S. Patent 6046740).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristina B. Honeycutt whose telephone number is 571-272-4123. The examiner can normally be reached on 8:00 am - 5:00 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

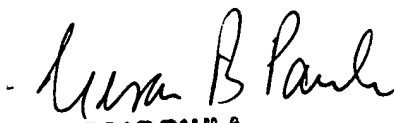
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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